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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,087	06/20/2003	Jotinderpal S. Sidhu	07K8-105445	8674

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EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,087

Applicant(s)

SIDHU ET AL.

Examiner

Mathieu D. Vargot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 29-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/26/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1.Applicant's election with traverse of Group I, claims 1-28 in the reply filed on November 3, 2005 is acknowledged. The traversal is on the ground(s) that the inventions are not properly restricted. This is not found persuasive because there is no evidence to show that the instant optical part comprising the insert would have been made through other methods such as placing a non-heat-soaked insert into place within a mold and slowly casting the desired resin therearound so that the insert would be warmed by the resin gradually and forced into place by the resin—ie, preconditioning by heat soaking would not be required.

The requirement is still deemed proper and is therefore made FINAL.

2.The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7, 13 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Beeloo et al (see Example1).

Beeloo et al (Fig. 2) discloses the instant method of preconditioning an insert to be used in injection molding lenses by placing the insert (polarizer film 56) in position against a molding surface (52), the molding surface having been heated so that the film itself becomes heat-soaked. Example 1 teaches (and Figure 2 shows) that the film is initially flat prior to being heat-soaked by the mold, and hence the curvature of the insert is

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measurably different from the curvature of the molding surface. Given that seal 60 presses a portion of the film against the mold surface 52, it is submitted that such would encompass the instant step of "placing the...insert...in position...against...molding surface" as set forth in claims 1 and 13.

3.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 8-12, 14-18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beeloo et al (see col. 1, lines 35-40; col. 4, lines 9-15; col. 6, line 36) in view of Smith et al .

The applied reference discloses the basic claimed method lacking essentially the aspects of the insert preferentially absorbing the energy used for the soaking, that IR energy is used, as well as microwave, UV and RF and that a multilayered insert is used. Beeloo et al applied heat to the mold to heat-soak the film insert. However, Smith et al (col. 7, lines 20-21) uses IR to heat up a polarizer film and subsequently form same to the mold. It would have been obvious to have employed IR heat to heat-soak the film in Beeloo et al as generally taught by Smith et al. Certainly, the additional forms of energy such as microwave, UV and RF are well known in the art as ways to heat up a preform which is to be subsequently formed against a mold and such would have been obvious equivalents to IR. One of ordinary skill in the art knows to tailor the particular form of heating so that the object to be heated preferentially absorbs the energy applied to

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perform the heating. Beeloo et al discusses employing polarizing inserts which have support layers. While such may not be preferred, a reference is to be considered for all it teaches, not merely preferred embodiments, In re Boe, 148 USPQ 507. The exact curvature of the insert vis-à-vis the curvature of the molding surface would have been obvious dependent on exactly how the insert is initially fashioned.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianne, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
February 3, 2006


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

2/3/06